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Attorney Docket No.: YO999-411

**REMARKS**

The present application was filed on November 9, 1999 with claims 1 through 58. Claims 1 through 58 are presently pending in the above-identified patent application.

5 In the present Office Action, the Examiner indicated that the claims are rejected as indicated in the prior final Office Action dated December 6, 2004. In the cited Office Action, the Examiner rejected claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57 under 35 U.S.C. §103(a) as being unpatentable over Li et al. (United States Patent Number 6,219,793 B1), and further in view of MacDoran et al. (United States 10 Patent Number 5,757,916), and rejected claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58 under 35 U.S.C. §103(a) as being unpatentable over Li et al. in view of MacDoran et al., and further in view of "Wireless Enhanced 9-1-1 Service – Making it a Reality," Bell Labs Technical Journal (Autumn 1996) by Meyer et al. (hereinafter Meyer et al.).

15 Applicants query whether the "finality" of the present Office Action was appropriate in view of the Request for Continued Examination filed on May 23, 2006.

**Independent Claims 1, 16, 27, 38, 39, 42, 45, 49, 52 and 55**

Independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al., and further in view of MacDoran. In the prior Final Office Action dated December 6, 2004, the Examiner asserts that Li teaches a challenge-response to authenticate a wireless communication, but acknowledges that Li does not disclose a "challenge response method that uses the location." The Examiner asserts, however, that MacDoran discloses a "method of providing the location of the client ...and granting access to the user if the location is within a predetermined threshold." In the Response to Arguments section of the final 20 Office Action, the Examiner asserts the following points:

4. MacDoran discloses that the LSS device can also be configured into a single microchip for integration into original equipment manufactured products (col. 15, lines 43-47 and 58-59) and that this allows each user to have a separate GPS device.

30 5. MacDoran discloses authentication (of) a user or device by using various methods such as passwords, PIN's, smart cards, PCMCIA cards, and biometric

Attorney Docket No.: YO999-411

authentication (col. 1, lines 21-55), and that this meets the limitation of authenticating an individual person.

6. Although MacDoran discloses that "the definition does not extend to individual users that operate an entity, because the invention does not have the ability 5 to authenticate an individual person," does not mean that creating a system that can authenticate an individual user is therefore not taught by MacDoran.

7. MacDoran discloses the "host authentication server produces a remote client location that matches the previously registered client location within a predetermined threshold, such as 3 meters, access is granted to the remote client user" 10 (col. 24, lines 18-29).

8. MacDoren discloses comparing the location of the client with the location stored in the database (col. 24, lines 14-16).

9. The Examiner asserts that, "in order to biometrically authenticate the user has to be present at the location of the transmitting device or else it would be 15 impossible to accomplish any of the previously described biometric authentication techniques."

10. Meyer discloses "using 911 techniques or querying the user about something at the location of a requested device or facility."

In the present Office Action, the Examiner asserts that the limitation added 20 in the Voluntary Amendment dated May 23, 2006, has already been considered by The Board of Patent Appeal and Interference (see, page 2, paragraph 1, where the board considered a "portable device" of a user). The Examiner further asserts that, therefore, the added limitation has already been considered by the BPAI and, based on such consideration, a decision has been rendered.

25 Applicants note that the text cited from the Board decision by the Examiner indicates that

the claimed invention relates to a global positioning system (GPS) -based access control method and apparatus in which access to a device or a secure facility is limited by verifying an authorized user's 30 location. More particularly, the GPS-based access controls system confirms that a user requesting access is actually physically present at the location of the device or secure location. The user's location is obtained by use of an individual GPS system carried by each user on a portable

Attorney Docket No.: YO999-411

device, such as a pocket token, computer-readable card, cellular telephone, or watch. If the location of a person making an access control request does not match the coordinates of the GPS device worn by an authorized user, the person requesting access is unauthorized.

5 (Page 1, last paragraph, to page 2, paragraph 1, of the Decision on Appeal.)

Clearly, in the text cited by the Examiner, the board is summarizing basic principles of the present invention. The board, however, sustains or overturns the rejections made by the Examiner based on the limitations of the *claims*. Since the limitation added in the Voluntary Amendment was not included in the claim set submitted in the Appeal Brief, the added limitation was not considered by the board in deciding the patentability of the cited patent. Thus, contrary to the Examiner's assertion, the added limitation was *not* considered by the BPAI and the decision rendered was *not* based on such consideration.

15 In addition, Applicants note that none of the cited references disclose or suggest identifying a location of an authorized person associated with a response, wherein the location is identified by *utilizing a portable device assigned to a user*.

Applicants note that MacDoran is directed to a method and apparatus for authenticating the identity of a remote user *entity* where the identity of such user entity is authenticated by use of information specific to geodetic location of the user *entity* (see, 20 Abstract). MacDoran compares the *expected location of an electronic device* with the *current location of the device* and will not allow access if the locations do not match. The present invention, alternatively, is directed to authenticating a user by confirming the location of the user utilizing, for example, a GPS device carried by the user. Thus, MacDoran would require a *single GPS device located at a client machine* and the present 25 invention would require, for example, a *separate GPS device for each user* of the client machine.

Applicants also note that MacDoran defines "entity" as an electronic device and specifically states that this definition "*does not extend to individual users* that operate an entity, because the invention does *not* have the ability to authenticate an 30 individual person." (Col. 6, lines 59-65; emphasis added.) Thus, MacDoran actually teaches away from the present invention by teaching that the invention cannot be used to authenticate an individual person.

Attorney Docket No.: YO999-411

In any case, MacDoran et al. clearly do not disclose or suggest wherein the location is identified by utilizing a portable device *assigned to a user*. Please note that dictionary.com defines "assign" as "to transfer (property, rights, or interests) from one to another." Thus, a person of ordinary skill in the art would recognize that the assignment of a portable device to a user infers more than a transient use of the device.

5 Thus, Li et al. and MacDoran et al., alone or in combination, do not disclose or suggest wherein said location is identified by utilizing a portable device assigned to said user, as required by independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55

10 Additional Cited References

Meyer et al. was also cited by the Examiner for its disclosure of asking the cell phone user "Do you have any more details on your location?" (Meyer: page 189, right column, lines 1-2; see, also, issue 10 above.) Applicants note that Meyer is directed to enhanced 9-1-1 service for wireless networks. Meyer does not disclose or suggest the identification of a user as described in the limitations of the independent claims. Furthermore, Meyer et al. do not disclose or suggest wherein the location is identified by utilizing a portable device assigned to a user.

20 Thus, Li et al., MacDoran et al., and Meyer et al., alone or in combination, do not disclose or suggest wherein said location is identified by utilizing a portable device assigned to said user, as required by independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55

Previous Rejections

Regarding issue 4, Applicants note that, even if each user is capable of having a separate GPS device, MacDoran does *not* disclose or suggest that each user has 25 or should have a separate GPS device.

30 Regarding issue 5, the techniques cited by the Examiner as being disclosed by MacDoran (passwords, PIN's and biometric authentication) are techniques for attempting to authenticate an individual person. The tests cited by the Examiner, however, can falsely authenticate an individual who is actually an impostor, as would be apparent to a person of ordinary skill in the art. For example, fingerprints on artificial limbs are known to have been authenticated by fingerprint systems as belonging to an

Attorney Docket No.: YO999-411

authorized user. The location of the authorized user may not be the same as the location of the electronic device in the system taught by MacDoran since an impostor who has acquired such an artificial limb and/or the authorized user's password may access an electronic device while the authorized user is at another location. In the present invention, the location of the authorized user is determined in order to prevent such false authentications. Thus, MacDoran does not disclose identifying the location of the authorized user.

Regarding issue 6, Applicants maintain that MacDoran's teaching that "the definition does not extend to individual users that operate an entity, because the invention does not have the ability to authenticate an individual person" clearly means that MacDoran does not disclose or suggest a system that can authenticate an individual user.

Regarding issue 7, Applicants note that MacDoran discloses identifying the location of the remote client machine, not identifying the location of an authorized user.

Regarding issue 8, in the text cited by the Examiner, Applicants could find no disclosure by MacDoran of "comparing a location of each identified potential users." MacDoran only discloses comparing a location of a client machine.

Regarding issue 9, as Applicants previously noted, biometric authentication systems may falsely authenticate a user by, for example, comparing a fingerprint on an artificial limb with a fingerprint image stored in a database. Thus, the authorized user may not be at the location where the biometric authentication is performed even if the biometric authentication (falsely) confirms the user's identity.

Dependent Claims 2-15, 17-26, 28-37, 40, 41, 43, 44, 46-48, 50, 51, 53, 54  
25 and 56-58

Dependent claims 2-11, 13, 15, 17-21, 24, 26, 28-32, 35, 37, 40, 41, 43, 44, 46, 47, and 50, 51, 53, 54, and 56-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al., and further in view of MacDoran et al. and dependent claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al. in view of MacDoran et al., and further in view of Meyer et al.

Attorney Docket No.: YO999-411

Claims 2-15, 17-26, 28-37, 40-41, 43-44, 46-48, 50-51, 53-54, and 56-58 are dependent on claims 1, 16, 27, 39, 42, 45, 49, 52, and 55, respectively, and are therefore patentably distinguished over Li et al., MacDoran et al., and Meyer et al. (alone or in any combination) because of their dependency from amended independent claims 1,  
5 16, 27, 39, 42, 45, 49, 52, and 55 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims, i.e., claims 1-58, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further  
10 suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,



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